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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/051,443	04/10/1998	CARIN WIDERSTROM	06275/124001	8003

26161 7590 06/26/2008

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EXAMINER	
YU, JUSTINE ROMANG	
ART UNIT	PAPER NUMBER
3771	

MAIL DATE	DELIVERY MODE
06/26/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARIN WIDERSTROM

Appeal 2007-4164
Application 09/051,443
Technology Center 3700

Decided: June 26, 2008

Before WILLIAM F. PATE III, LINDA E. HORNER, and
JOHN C. KERINS, *Administrative Patent Judges*.

WILLIAM F. PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

This is an appeal from the final rejection of claims 1-5 and 7-12. These are all of the claims in the application.

The copy of the claims appended to Appellant's brief is incorrect. A correct Claims Appendix was furnished to the Board by facsimile on May 15, 2008 after the hearing.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6 and §134.

The claimed invention is directed to a disposable inhaler device which dispenses powdered medicaments into the air stream as the air is inhaled. The specific feature of Appellant's invention is that the inhaler comprises individual containers of medicine, the medicine in the containers being of different dose sizes.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A single use inhaler for administering medicament by inhalation, the inhaler comprising:
>
> an inhalation channel through which a user may inhale;
>
> a first container containing a first dose of medicament; and
>
> a first release means for releasing said first dose into the said inhalation channel; wherein the inhaler further comprises:
>
> at least one subsidiary container for containing a subsidiary dose of medicament;
>
> at least one respective subsidiary release means for releasing said subsidiary dose into said inhalation channel; wherein
>
> said first release means is independently operable of said at least one subsidiary release means such that one or more of said first dose and said subsidiary dose may be released into said inhalation channel at the same time and such that a variable dose is provided and the subsidiary dose of said at least one said subsidiary container is a predetermined fraction of said first dose that is less than said first dose.

REFERENCES

The references of record relied upon by the examiner as evidence of obviousness are:

Gonda	5,743,250	Apr. 28, 1998
Källstrand	5,533,505	Jul. 09, 1996
Goettenauer	5,881,719	Mar. 16, 1999
Goettenauer (as translated)	DE 4,400,084 A1	Jul. 06, 1995

REJECTIONS

Claims 1-5, 7, and 8 stand rejected under 35 U.S.C. § 103 as unpatentable over Goettenauer '084 in view of Gonda.

Claims 9-12 stand rejected under 35 U.S.C. § 103 as unpatentable over Goettenauer '719 in view of Gonda.

Claims 1-5, 7, and 8 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-19 of Källstrand in view of Gonda.

OPINION

For a teaching of an inhaler with differing amounts of medicaments in each container, the Examiner has cited the Gonda reference. Gonda states in col. 42, ll. 24-28 that, "[i]n addition to disclosing specific information regarding the day and time for drug delivery[,] the indices could provide more detailed information such as the amount of insulin dispensed from each container which might be particularly useful if the containers included different amounts of insulin." We are in agreement with Appellant that this disclosure is inexact and is susceptible of two different interpretations. The

Examiner interprets the quoted passage to mean that the containers 1 having collapsible walls 2 which hold the medicament 5 have flexible walls 2 of different sizes on the same disposable package 46. See, generally, col. 16, l. 66 to col. 18, l. 46 and Fig. 4. Appellant interprets this phrase to mean that the containers 1, provided in the kit containing the device 40, are provided in disposable packages 46 with different amounts in the containers of each disposable package. We agree with the Appellant that the quoted phrase is amenable to these two different interpretations, and that each interpretation is as likely to be true as the other interpretation.

Fortunately, the law provides a way out of this conundrum. In the first instance, the Examiner has the burden of proof of establishing prima facie obviousness by a preponderance of the evidence. That is, the Examiner must show that it is more likely than not that the references teach the features that the Examiner relies upon. In this instance, since it is equally likely that the Appellant's interpretation of the reference is correct, rather than the Examiner's, the Examiner has not satisfied his burden of a preponderance of the evidence. Accordingly, we are unable to credit that the combination of Gottenauer '084 and Gonda, would be able, when modified, to release a first dose and a subsidiary dose into the inhalation channel at the same time as required by claim 1. Nor would a combination of Gottenauer '719 and Gonda be suitable for arranging for the release of a first dose and a subsidiary dose at the same time as required by the method of claim 9. This also holds true for the obviousness-type double patenting rejection that relies on Gonda.

On the other hand, when analyzing the method of claim 10 we do not find therein the simultaneous limitation from claims 1 and 9. Therefore, even if the containers with different amounts of medicaments were on different disposable packages 46 as per Appellant's interpretation of the quoted phrase of Gonda, the method of claim 10 is still taught by Gonda in that one disposable package with one amount could be used followed by another disposable package with another amount in a method of providing a variable quantity of substances in an administration device. Since Gonda teaches all of the limitations of claim 10, we will affirm the obviousness rejection of claim 10 as unpatentable over Goettenauer '719 in view of Gonda, since anticipation is the epitome of obviousness. *See in re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2003) (quoting *Sears Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Claims 11 and 12 fall with claim 10.

CONCLUSION

The rejection of claims 1-5 and 7-8 under 35 U.S.C. § 103 as unpatentable over Goettenauer '084 in view of Gonda is reversed.

The rejection of claim 9 under 35 U.S.C. § 103 as unpatentable over Goettenauer '719 in view of Gonda is reversed.

The rejection of claims 10-12 under 35 U.S.C. § 103 as unpatentable over Goettenauer '719 in view of Gonda is affirmed.

The double patenting rejection of claims 1-5, 7 and 8 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

vsh

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